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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,215	09/24/2003	Valerie Sue Adams	71553	4646

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,215

Applicant(s)

ADAMS ET AL.

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 28-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The electronic file for the instant application lacks an oath/declaration. Applicant's original transmittal letter indicated a copy of the parent's oath was provided, but the examiner is unable to locate it. An oath/declaration must be provided with the next response.

Claims 1-4, 7-10, 12, 15-20, 31-37, 39, 40 and 42 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Sublett '944 Patent.

Sublett suggests blends of polycarbonate with polyester (column 2, lines 4-6). The polyester is based on dimethyl terephthalate, cyclohexane dimethanol and optionally ethylene glycol (column 2, lines 11-15). The catalyst for making the polyester is present in amounts to provide 10-100 ppm titanium (column 2, line 20).

A phosphate may also be present in the catalyst system (column 2, line 41).

Claims 1-4, 7-10, 12, 15-20, 31-37, 39, 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Sublett '944 Patent in view of Hamilton '816 or the Smith Article in Journal of Applied Polymer Science.

Sublett suggests a range of titanium amounts, but does not point out advantages in picking the lower end amounts.

Hamilton (column 1, lines 24-31; column 2, line 59) and Smith (page 4237) explain residual titanium catalyst from the polyester negatively affects polyester/polycarbonate blends.

One of ordinary skill seeking to minimize these problems in Sublett's blend would choose lesser amounts of catalyst when producing the polyester.

Claims 1-10, 12-20, 31-40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Sublett '944 Patent in view of Small '610 optionally in further view of Hamilton '816 or the Smith Article.

Sublett does not suggest adding distearyl pentaerythritol diphosphate to the PC/polyester blend.

This and other phosphates are known to improve the melt stability of PC/polyester blends (column 2, lines 26; column 4, line 5 of Small). It would have been obvious to add these phosphites to Sublett's blend for the expected improvements.

Hamilton and Smith can be relied on to choose low amounts of titanium catalyst as previously explained.

Claims 1-13, 15-26, 28-37 and 39-42 rejected under 35 U.S.C. 103(a) as being unpatentable over the Allen '692 Patent in view of Hilbert '133.

Allen blends polycarbonate with polyester (abstract). The polyester can be based on cyclohexaned dimethanol, ethylene glycol and terephthalic acid (column 9, line 3) in the ratios preferred by applicant in claim 20. Alternatively, the polyester can be based on cyclohexane dimethanol, isophthalic acid and terephthalic acid (column 10, line 3) in the ratios preferred by applicant in claim 21. Various catalysts can be used (column 7, line 67) to polymerize the polyester, but Allen does not describe the amount of titanium.

Hilbert discloses such a low titanium catalyst system for making polyesters (column 2, line 57). Furthermore, Hilbert's catalyst system includes a combination of toners (column 5, lines 31-40) and phosphorous (column 2, line 61).

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It would have been obvious to use Hilbert's catalyst system when making the polyester of Allen's polyester/PC blend. This low-level titanium catalyst system would be expected to minimize the well-known problems associated with residual titanium in polyester/PC blends.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 and 28-42 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6723768. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent also claims blends of polyester with polycarbonate where the polyester is made with a small amount of titanium catalyst. The instant claims are broader in the sense that toner copolymerizable monomers are not required.

Adams '918 is cited for its low titanium catalyst system.

Applicant's arguments filed 8/16/05 have been fully considered but they are not persuasive.

Applicant argues Sublett does not anticipate the claims because he does not provide an example at a titanium level of 1-30ppm.

This is not convincing. Disclosed examples and preferred embodiments do not constitute a teaching away from broader disclosure (MPEP 2123).

Applicant refers to the specifications's tables 2 and 3 to show unexpected results for the low levels of titanium.

These tables do not include the alkali/alkaline earth metal called for by Sublett. The closest prior art was not compared as required by MPEP 716.02(e).

Applicant argues Hamilton and Smith would suggest deactivating the titanium rather than minimizing the original titanium content.

The rejection did not rely on the "inventive concept" of Hamilton and Smith. Hamilton and Smith were cited merely for their backgrounds which describe the negative effects of residual titanium in polycarbonate/polyester blends. Because residual titanium catalyst has negative consequences for polycarbonate/polyester blends, one would use as little titanium as possible in making the polyester.

Applicant argues Allen is directed to amorphous polyesters while Hilbert is directed to crystalline polyesters and therefore Hilbert's catalyst would not be useful to make Allen's polyesters.

Hilbert teaches his catalyst system is useful for polymerizing polyesters based on terephthalic acid, ethylene glycol and cyclohexanedimethanol (col 3 line 65). This makes the same polyester as called for by Allen (and applicant). This improved method for making polyesters is applicable for polyesters in PC/polyester blends because it is

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obvious to improve a blend by improving a component of the blend (Ex parte Westphal 26 USPQ2nd 1858; Cosden Oil & Chemical v. American Hoechst 214 USPQ 244).

The terminal disclaimer filed on 8/16/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US6723768 has been reviewed and is NOT accepted.

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Any questions regarding approval/disapproval of terminal disclaimers should be directed to Bill Krynski 571-272-1024.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

David Buttner

10/3/05

